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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/026,290 | 12/20/2001 | Roger J. Talish | 41482/269109 | 8454 |

23370 7590 09/23/2004

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| EXAMINER |
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JUNG, WILLIAM C

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| ART UNIT | PAPER NUMBER |
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3737

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/026,290 | Applicant(s) TALISH ET AL. <i>cl</i> | |
| | Examiner William Jung | Art Unit 3737 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>21012003, 17072003, 12022004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-32 are rejected under the judicially created doctrine of double patenting over claims 1-21 of U. S. Patent No. 6,355,006 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 1: US Pat. No. 6,355,006 discloses a same invention in claim 1 where a kit for ultrasonically stimulating cartilage growth, which consists of means for initiating a biological healing response at or adjacent a cartilaginous site where an ultrasonic transducer assembly having at least one ultrasonic transducer, a placement module configured to be worn by a patient where the placement module being configured to receive said transducer assembly such that when the placement module is worn at least one ultrasonic transducer is positioned in proximity to the channels, an ultrasonic signal generator positioned in the ultrasonic transducer assembly

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and operative between a signal generating mode and a non-signal generating mode, wherein at the signal generating mode the ultrasonic signal generator emits ultrasound signals, timing means for automatically placing the ultrasonic signal generator from the signal generating mode to the non-signal generating mode after a predetermined period of time; and a main operating unit.

Corresponding dependent claims 2-17 are substantially disclosed in claims 2-11.

Claim 18: US Pat. No. 6,355,006 discloses a same invention in claim 12 where a method for ultrasonically stimulating a healing response for the regeneration of cartilage including the steps of initiating a biological healing response at or adjacent a cartilaginous site; providing a main operating unit having an internal power source coupled to an ultrasonic transducer assembly, the ultrasonic transducer assembly includes at least one ultrasonic transducer, an ultrasonic signal generator and signal generator circuitry therein, providing a placement module configured to receive said transducer assembly such that when the placement module is secured to a patient's body at least one ultrasonic transducer is positioned in proximity to the channels, exciting at least one ultrasonic transducer to impinge ultrasonic waves towards the cartilaginous site, providing a timing mechanism for clocking the amount or time at least one ultrasonic transducer is excited, and automatically turning off at least one ultrasonic transducer after the timing mechanism has clocked a predetermined period of time. Corresponding dependent claims 19-27 are substantially disclosed in claims 13-18.

Claim 28: US Pat. No. 6,355,006 discloses a same invention in claim 19 where a method for ultrasonically stimulating a healing response for the regeneration of cartilage consisting the steps of initiating a biological healing response at or adjacent a cartilaginous site, releasably securing at least one ultrasonic transducer coupled to a signal generator to a band, affixing the band on a

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patient such that said at least one transducer is in proximity to an area where the regeneration of cartilage is desired; exciting said at least one ultrasonic transducer by actuating the signal generator to impinge ultrasonic waves towards the cartilaginous site, providing a timing mechanism for clocking the amount of time at least one ultrasonic transducer is excited, and automatically turning off at least one ultrasonic transducer after the timing mechanism has clocked a predetermined period of time. Corresponding dependent claims 29-32 are substantially disclosed in claims 20 and 21.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Senge et al (US 4,905,671), *Winder et al* (US 5,520,612), *Kaufman et al* (US 5,547,459, 5,752,924), and *Duarte et al* (US 6,190,336)

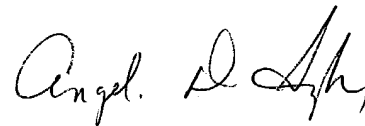
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 703-605-4364. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJ
September 18, 2004



ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700